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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,076	10/24/2001	Wenjun Luo	3COM2257-2	6227
22470	7590	06/09/2006	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP			CHANKONG, DOHM	
P O BOX 366			ART UNIT	
HALF MOON BAY, CA 94019			PAPER NUMBER	
			2152	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,076

Applicant(s)

LUO ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 25-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 25-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- 1> This action is in response to Applicant's amendment and remarks, filed 3.20.2006. Claims 46-60 have been added. Claims 22 and 25-60 are presented for further examination.
- 2> This is a final rejection.

Response to Arguments

1. The effective priority date of the present application is January 24, 2000

Applicant's arguments in regards to the 35 U.S.C § 102(e) rejection of claims 22, 25, 28-30, 35, 39, 42 and 45 as being anticipated by the Beck reference have been fully considered but they are not persuasive. The present application is a continuation-in-part of application 09/237,609 (now patent 6,216,158), which was filed January 25, 1999. Applicant argues that the claims deserve the benefit of the priority date of January 25, 1999. In determining the effective filing date:

"If the application is a continuation-in-part of an earlier U.S. application...any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application."

MPEP §706.02(V)(B).

Here, Applicant's claim 22 contains functionality that does not meet the 35 U.S.C §112 requirement. For instance, the parent application does not describe learning the network addresses of services in a group nor does the parent application have any description of determining or notifying a particular service as acting as an application host. Thus, the

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present application has an effective filing date equal to the filing date of the new application only, not of the parent application. The present application is the national state filing of PCT/US00/01634 which was filed on January 24, 2000. Thus, the present application has an effective filing date of January 24, 2000, not January 25, 1999.

Since the Beck reference has an effective filing date of March 31, 1999, Beck qualifies as prior art. The 35 U.S.C 102(e) rejections are proper and these rejections are maintained.

II. Ortony does not teach away from modification nor does modifying Ortony destroy its purpose

Applicant first argues that Ortony teaches away from learning new addresses simply because Ortony discloses utilizing preset addresses. However, “[a] prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” (emphasis added) See In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). In other words, to constitute “teaching away”, a prior art should criticize, discredit or otherwise discourage the solution.

Here, Ortony neither criticizes, discredits or even discourages the function of learning new addresses. Ortony does not teach away from learning new addresses simply because he discloses utilizing preset addresses.

Applicant additionally argues that modification of Ortony would destroy his purpose to limit availability of services to children. This argument presumes that a system can only utilize either a preset address or dynamic learning of new addresses. However, it is clear to one of ordinary skill in the art that both mechanisms can coexist in the same system. For

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example, the Orenshteyn reference discloses that both mechanisms, preset addresses and dynamic learning of new addresses, can be utilized together in the same system [column 12 «line 60» to column 13 «line 4»]. That is, Orenshteyn discloses preset addresses stored in a configuration file and learning new addresses.

Thus, modification of Ortony does not result in destruction of his intended purpose. Rather, modification of Ortony, in view of Orenshteyn, results in additional functionality that supplements, but does not replace, Ortony's current system.

III. Motivation to combine Frese and Orenshteyn comes from both the prior art references and common knowledge of one of ordinary skill in the art

Next, Applicant argues that there is a lack of motivation to combine Frese and Orenshteyn. It should be noted that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Here, the motivation to combine comes from the teachings of the prior art as well as knowledge of persons of ordinary skill in the art. Thus, Applicant's citation towards MPEP § 2144.03(c) is misplaced. That section focuses on Official Notices and is not applicable here because the motivation to combine was not a factual assertion, but rather taken from the prior art teaching.

Orenshteyn discloses that the ability to discover new service addresses allows a user to “roam” [column 5 «lines 10-15»]. Additionally, Orenshteyn discloses that new service addresses (that have not stored in a configuration file) can be learned [column 12 «line 60» to

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column 13 «line 4»]. As would be obvious to one of ordinary skill in the art, these teachings imply a means of learning new service addresses beyond what has already known by the user computer. In other words, service addresses are learned dynamically. This is clearly an improvement over both Frese and Ortony. Thus, the motivation to modify Frese with Orenshteyn's teachings comes expressly from Orenshteyn and from knowledge of persons of ordinary skill in the art.

IV. Official Notices with regard to claims 26, 28-30, 32-34 and 38 are taken to be admitted prior art because Applicant failed to traverse

Claims 26, 28-30, 32-34 and 38 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of an Official Notice. A failure to traverse an Official Notice (or any well-known-in-the-art statements) will result in taking the Official Notice to be admitted prior art. See MPEP 2144.03(C).

Here, Applicant has not traversed the use of Official Notice for claims 26, 28-30, 32-34 and 38. Thus, the Official Notice statements that one of ordinary skill in the art would have reasonably implemented the aforementioned services in Ortony to provide a greater range of functionality of services available to the user and that the dimension of a touch screen on a handheld device is a matter of preference, and one of reasonable skill in the art would have reasonably inferred that the touch screen would have to be at least a minimum size to fit on the handheld or portable device are taken as admitted prior art by the Applicant.

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V. Orenshteyn discloses the limitation of sending user interface constructs for incorporation in the user interface program

Applicant argues new claims 46-60 are patentable because Ortony and Orenshteyn fail to teach the limitation of sending user interface constructs. Applicant points to Orenshteyn's use of a quasi-OS on the client computer as support. However, Orenshteyn discloses that the quasi-OS is explicitly controlled using interface constructs submitted by the server [column 5 «lines 25-31» | column 7 «line 64» to column 8 «line 14»]. Applicant asserts that the quasi-OS generates the interface constructs. However, Orenshteyn does not support this supposition. The commands (or constructs) are in fact submitted by the server.

These commands embody the behavior of the interface. The quasi-OS receives these commands and incorporates them into the user interface. Contrary to Applicant's assertion, the server, not the quasi-OS, generates the interface constructs which are then incorporated into the user interface by the quasi-OS. As interpreted by the Office, the user interface constructs of claims 25 and 46 are merely commands that are incorporated into the user interface. Thus, Applicant's argument that Orenshteyn does not disclose sending user interface constructs is not persuasive.

VI. Conclusion

Applicant's arguments are not persuasive and the prior art rejections set forth in the previous action, filed 12.22.2005, are maintained.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4> Claims 22, 25, 28-30, 35, 39, 42, 45-47, 50-52 and 57 are rejected under 35 U.S.C § 102(e) as being anticipated by Beck et al, U.S Patent No. 6,604,140 ["Beck"].

5> As to claims 46 and 47, as it does not teach or further define over the previously claimed limitations, it is similarly rejected for at least the same reasons set forth for claims 22 and 25.

6> As to claims 50-52 and 57, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 28-30, 35 and 39, respectively.

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Claim Rejections - 35 USC § 103

7> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9> Claims 22, 25, 27, 31, 35, 37, 46, 47, 49, 53, 57 and 59 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, U.S Patent No. 6,038,595, in view of Orenshteyn, U.S Patent No. 5,889,942, in further view of Frese, II et al, U.S Patent No. 5,909,545 ["Frese"].

10> As to claims 46 and 47, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 22 and 25.

11> As to claims 49, 53, 57 and 59, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 27, 31, 35 and 37, respectively.

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12> Claims 26, 28-30, 32-34, 38, 48, 50-52, 54-56 and 60 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of an Official Notice.

13> As to claims 48, 50-52, 54-56 and 60, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 26, 28-30, 32-34, 38 respectively.

14> Claims 36 and 58 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of Whitehead et al, U.S Patent No. 6,085,030 ["Whitehead"].

15> As to claim 58, as it does not teach or further define over the previously claimed limitations, its is similarly rejected for at least the same reasons set forth for claim 36.

16> Claims 39, 42, 44 and 45 are rejected under 35 U.S.C § 103(a) as being unpatentable over Frese, in view of Ortony, in further view of Orenshteyn.

17> Claims 40 and 41 are rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Myers et al, "Collaboration Using Multiple PDAs connected to a PC" ["Myers"].

18> Claim 43 is rejected under 35 U.S.C § 103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dean et al, U.S Patent No. 6,055,512;

Riggins et al, U.S Patent No. 6,131,116;

Kavner, U.S Patent No. 6,289,390;

Graham et al, U.S Patent No. 6,594,700;

Zintel et al, U.S Patent No. 6,725,281;

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

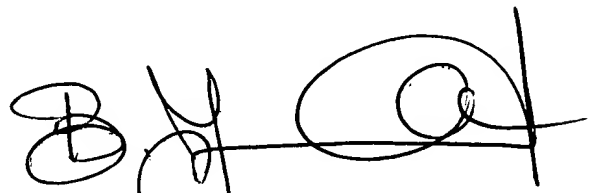
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER